



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/784,980

02/16/2001

Anthony John Bell

5641C1-07-LAV

5253

7590 02/26/2008
Allen R. Kipnes, Esq.
WATOV & KIPNES, P.C.
P.O. Box 247
Princeton Junction, NJ 08550

EXAMINER

CHAWLA, JYOTI

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/784,980	Applicant(s) BELL ET AL.	
	Examiner JYOTI CHAWLA	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 46-55 is/are pending in the application.
4a) Of the above claim(s) 10-27 and 46-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 28-36 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment filed on November 11, 2007 has been entered. Claims 1-36 and 46-55 are pending in the application. Claims 10-27 and 46-54 were withdrawn from further consideration as being directed to a non-elected invention. Claims 1, 28 and 55 have been amended. Claims 1-9, 28-36 and 55 are examined in the present office action.

Claim Objections

Claim 7 is objected once again because of the following informalities:

The claim has wrong dependence as it depends on claim 7. For the purpose of expediting the examination claim 7 would be regarded as depending from claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Rejection of claims 1-9, 28-36 and 55 under 35 U.S.C. 112, first paragraph, for using the term "a chemically induced unpleasant mouth feel" has been withdrawn based on applicant's amendment to remove the term from the claims.

Claims 1-9, 28-36 and 55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 28 and 55 recite "one or more partially hydrogenated vegetable oils or saturated fats, said amount being effective

Art Unit: 1794

alone to suppress said unpleasant mouth feel of said botanical.” The term “alone” as recited in claims 1, 28 and 55 was not described in the specification as such. While it may be true that the one or more partially hydrogenated vegetable oils or saturated fats, said amount being effective to suppress said unpleasant mouth feel of a botanical, however, there is no evidence or support provided by the applicant that shows that the fats are able to suppress the unpleasant mouth feel *alone*, i.e., to the exclusion of all other components of the confection. Applicant’s arguments on pages 12,14-16, regarding the ability of vegetable oils or saturated fats *alone* to suppress the unpleasant moth feel is not supported by the rejected claims which clearly recite presence of at least one sugar an one carbohydrate bulking agent in the composition. It is also noted that the claims 1, 28 and 55 recite “a candy composition.. comprising”, i.e., composition may have other ingredients in it. Further applicant’s disclosure includes the addition of flavorants and acids to the confection (Specification page 7, lines 30-32 and Example 2, Page 10). Thus the specification discloses use of flavors and acids in the confection. Therefore applicant’s claim that one or more partially hydrogenated vegetable oils or saturated fats are effective *alone* to suppress said unpleasant mouth feel of confection with botanical does not find support in the specification.

Applicant’s remarks regarding the support of using the term “alone” (Remarks, page 12, paragraph 1) have been considered but have not been found persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 28-36 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 28 and 55 remain rejected for the recitation of the term “unpleasant mouth feel” as the term “unpleasant mouth feel” renders the claim indefinite. The invention as claimed addresses the suppression of unpleasant mouth feel caused by the botanicals.

Art Unit: 1794

Applicant's arguments regarding this matter (Remarks, Page 13) have been fully considered, however, it is unclear as to what constitutes "unpleasant mouthfeel" as recited. Unpleasant mouthfeel could be due to the taste of the product (e.g., bitter, sour, burning sensation on the tongue, tongue tingling, etc.), or due to chewing characteristics of the product, or due to the texture of the product (e.g., gritty or sticky, etc.) or due to the addition of a chemical. Also, the term "unpleasant mouthfeel" is indefinite as a food or flavor that might have unpleasant mouthfeel for some, would be desirable for others. The invention as claimed addresses the suppression of unpleasant mouthfeel caused by the botanicals. Thus applicant's arguments have not been found persuasive and the rejection is maintained for reasons provided herein and in the previous office actions.

Claim 1 is further rejected as it recites the limitation "said amount" in line 2. There is insufficient antecedent basis for this limitation in the claim as there is no mention of an amount previously in part (c) of the claim. Correction is required.

Claim 1 is also indefinite for the recitation of step (c) wherein "amount being effective alone to suppress said unpleasant mouth feel of said botanical" as it is unclear whether

- the claim as recited means that there are no other unpleasant mouth feel suppressing agents in the composition beside the oils or fats OR
- the claim as recited means that the fats or oils in the range of 0.5 to 5% are effective suppressing agents for unpleasant flavors etc alone ,i.e., just the fats in the composition are capable of suppressing the unpleasant mouth feel of the botanical and/or pharmaceutical component, with or without the help of other suppressing agents.

For the purposes of expediting the prosecution any confection with a botanical and/or pharmaceutical agent (which has unpleasant mouth feel) having one or more partially hydrogenated vegetable oils or saturated fats in the range of 0.5 to 5% would be considered relevant prior art.

Rejection of claims 1-9, 28-36 and 55 under 35 U.S.C. 112, second paragraph, for using the term "a chemically induced unpleasant mouth feel" has been withdrawn based on applicant's amendment to remove the term from the claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1, 2, 4-9, 28, 29, 31-36 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuragi et al. (EP 0732064 A1) in view of Seang et al (WO 94/05260).

Regarding claims 1, 28 and 55 the instantly claimed confection with at least one botanical and least one sugar and oils or fats in an amount effective alone to suppress the unpleasant mouth feel, Katsuragi et al., hereinafter Katsuragi, teaches of bitterness relieving agent for food, medicine, cosmetic uses. Katsuragi also teaches that the bitterness (i.e., unpleasant mouth feel) relieving agent can be added to medicinal compositions, Chinese orthodox drug preparations, such as Ginkgo biloba (Page 4, lines 26 to 33) (Claims 2, 29). Thus using a bitterness-relieving agent to suppress the unpleasant mouth feel associated with a botanical, as recited in claims 1, 2, 28, 29 and 55 was known at the time of the invention as taught by Katsuragi.

Regarding the composition being a hard boiled candy with at least one sugar and at least one carbohydrate bulking agent kept in an amorphous or glassy condition as instantly claimed, Katsuragi teaches that the bitterness relieving agent with the medicinal composition can be in various dosage forms, such as granules, pills, dusts, tablets, troches (lozenges or hard candy), chewable tablets and liquids (Page 4, lines 9-10, 26-37 and 57). Katsuragi also teaches of addition of bitterness relieving agent to foods such as, candies (which includes hard boiled candy), confectionary and boiling step for vegetables etc (Page 4, lines 9-10, 26-37 & 57 and Page 5, lines 7-8). Further

Art Unit: 1794

in examples Katsuragi teaches of sucrose, i.e., sugar. Thus Katsuragi teaches of all kinds of foods and confections including troches which are lozenges, such as, cough relieving lozenges or other similar product which are hard boiled candies. Katsuragi also teaches of sugars such as sucrose, lactose, mannitol etc in the compositions (Examples). Katsuragi also teaches that the preparations comprising the unpleasant or bitter component with bitterness relieving agent can be mixed with fillers (bulking agents), binders lubricants, masking agents and perfumes, etc. Thus the reference teaches of addition of fillers and/or binders to compositions comprising the bitterness relieving agent. Regarding the sugar and filler or bulking agent being a carbohydrate which is kept in amorphous or glassy condition Katsuragi teaches of candy and confections. It is well known in the art that candy or lozenge base comprises sugar and fillers that are maintained in a amorphous or glassy condition. Thus Katsuragi inherently teaches of the hard candy or lozenge or confection where the sugar and fillers that are maintained in a amorphous or glassy condition.

Katsuragi teaches that the bitterness-relieving agent comprises an ester of a glyceride (mono/di-glyceride and triglycerides, i.e., fats and oils) where preferred fatty acids (either saturated or unsaturated) ranging from 8-22 carbon atoms, including lauric acid, stearic acid, oleic acid, linoleic acid and linolenic acid (Page 3, lines 3-20). Katsuragi also teaches that the ester can also contain triglycerides (i.e., fats). Thus the bitterness (unpleasant mouth feel) relieving agent as taught by Katsuragi is a fat or oil (page 3, lines 3-20). The ester as taught by Katsuragi can be dissolved in edible oils (hydrogenated, transesterified or regular), such as palm kernel oil, milk fat and cottonseed oil to name a few, before using (Page 3, line 58 to Page 4, line 7) as instantly claimed. Thus Katsuragi teaches of a fat based bitterness relieving composition using esterified fatty acids with glycerol (i.e., fats) as instantly claimed. Regarding the amount of partially hydrogenated oils or saturated fats in the amount of 0.5 to 5% being effective alone to suppress the unpleasant mouth feel, it is noted that esterified fat based compound as taught by Katsuragi can be added from 0.01-10% in order to effectively suppress the unpleasant mouthfeel of the botanical (Page 4, line 42-

Art Unit: 1794

45), by dissolving the ester in the oil, the resulting oil becomes effective to suppress the unpleasant mouthfeel. Thus Katsuragi teaches of lipid based compound as a bitterness relieving agent, as recited in claims 1,6-9,28,33-36 (Also see Abstract, Page 3, lines 9-13, Page 3, line 58 to Page 4, line 5, Page 4, lines 25-47, Examples 3 and 4, Claims).

Further regarding fats in the amount of 0.5 to 5% being effective alone to mask the unpleasant mouth feel of the confection comprising a botanical, as recited in claim 1, 28 and 55, Seang et al., hereinafter Seang, teaches that lipid coating has been beneficially employed to mask the bitter taste of drugs (Page 1, line 28 to Page 2, line 2 and Page 4, lines 7-14). The reference also teaches that the lipid can be a saturated or unsaturated fat, or hydrogenated or partially hydrogenated oils, such as, cottonseed oil, castor oil, coconut oil or waxes (Page 6, lines 1-15 and pages 6-8) to mask the unpleasant taste and flavor of the pharmaceutical component. Regarding the amount of lipids that are effective alone to mask the unpleasant mouth feel of the drug composition Seang teaches 400mg of lipid (PURECO) in the total composition of 12.275 grams, i.e., the lipid component is 3.2% (Page 9-10, Inventive Examples 1-3) and about 2.1% (i.e., 267mg lipid in the total composition of 12.627 grams) (Page 11, Inventive Example 5). Thus Seang provides examples where the lipid or fats in amounts of 3.2% and 2.1% effectively mask the unpleasantness of the drug composition, which falls in the range of 0.5 to 5% as recited by the applicant in claim 1.

Thus taste masking of unpleasant mouth feel of confections comprising medicinal drugs and botanicals with fat based compounds was known at the time of the invention as taught by Katsuragi. It was also known at the time of the invention that the unpleasant mouth feel due to the presence of a botanical can be masked by the same taste masking agents as are used to mask the unpleasantness of the medicinal drugs (Katsuragi, Page 4). Furthermore, it was also known at the time of the invention that partly hydrogenated or fully hydrogenated or saturated fats in the amount recited by the applicant are capable alone (i.e., by themselves) to mask or suppress the unpleasantness of the mouth feel of medicinal drugs (Seang, Examples 1-3 and 5).

Art Unit: 1794

Therefore, not only would it be obvious to one of ordinary skill in the art at the time of the invention that partially hydrogenated or saturated fats in the amount as taught by Seang would be effective alone (i.e., by themselves) in masking the unpleasant mouth feel in a confection comprising a botanical, but one of ordinary skill would also have a reasonable expectation of success of suppressing the unpleasant mouth feel or bitterness of a compound by adding lipids in the amount as taught by Seang. Therefore, to modify Katsuragi's composition and add saturated fats or hydrogenated or partially hydrogenated fats in the amount taught by Seang, for their known function of effectively masking the unpleasant flavor of the botanical alone (i.e., by themselves) (Seang, page 1, line 28 to page 2, line 2 and examples 1-5) would have been obvious to one of ordinary skill in the art at the time of the invention. One would have been also motivated to add saturated fats or hydrogenated or partially hydrogenated fats to the confection as taught by Katsuragi in the amount as taught by Seang, in order to make a candy or confection comprising a botanical more easily by using commonly available edible fats or lipids while making the confection product more palatable, smooth and with a better mouth feel.

Regarding claims 2 and 29, Katsuragi teaches of a confection with botanicals, such as, Ginko biloba (Page 4, lines 30-34) as instantly claimed.

Regarding claims 4, 5, 31 and 32 Katsuragi teaches of addition of cottonseed oil, soybean oil, palm oil, sunflower oil, corn oil, palm kernel oil, coconut oil and milk fat (i.e., butter), either as such or fractionated or hydrogenated or transesterified form. Katsuragi also teaches of using the fats either alone or a combination of the fats can be used (Page 3, line 58 to page 4, line 5). Also Seang teaches of lipids to mask the unpleasant flavors include saturated or unsaturated fats, hydrogenated and partially hydrogenated oils, such as, cottonseed oil, coconut oil, and mixtures of oils and other lipids (page 6, lines 5-15). Thus both references meet the limitations recited in claims 4 and 5.

Art Unit: 1794

Regarding the amount of amount of fat in the candy composition as recited in claims 6, 33 and 7, 34 (i.e., 0.5% to 3.5% and 0.75% to 3.0% respectively), Katsuragi teaches of the fat based bitterness relieving agent in the amount 0.1 to 10% (Page 4, line 42-45) which includes the recited range of the applicant. Also the amount of lipid that is effective alone to suppress the unpleasant mouth feel as taught by Seang is 400mg of lipid (PURECO) in the total composition of 12.275 grams, i.e., the lipid component is 3.2% (Page 9-10, Inventive Examples 1-3) and about 2.1% (i.e., 267mg lipid in the total composition of 12.627 grams) (Page 11, Inventive Example 5). Thus Seang provides examples where the lipid or fats in amounts of 3.2% and 2.1% effectively mask the unpleasantness of the drug composition, which falls in the recited ranges. Thus both the references meet the limitation of fat content of the candy composition as recited by the applicant in claims 6, 33 and 7, 34. Further, since the effect of lipids in masking the unpleasant taste (e.g., bitterness) in the pharmaceutical compositions was known in the art, therefore, to select any particular level of the effective oil, such that the level is 0.5-5%, 0.5-3.5%, or 0.75 to 3.0% in the hard candy as instantly claimed, it would have been obvious to one of ordinary skill in the art at the time of the invention to vary the amount of partially hydrogenated or saturated fats or lipids in the confection depending on the bitterness of the botanical included, and also depending on the amount of botanical included.

Note: Also refer to the rejection of claim 1 above.

Katsuragi is silent as to the ratio recited in claims 8, 9, 35 and 36, however, Seang teaches that the ratio of the saturated fats or hydrogenated oils to the botanical (pharmaceutical drug, minerals, botanicals etc.) which is effective to suppress the unpleasant mouth feel of the pharmaceutical drug or minerals or botanicals etc is 0.25:1.0 to 2:1 (OR 1:4 to 1:0.5) (Page 8, lines 5-10), which includes the range recited by the applicant (i.e., 1.0/0.6 to 1.0/0.15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Katsuragi and add the amount of saturated fats or hydrogenated oil to the botanical in the ratio taught by Seang in order to make the confection comprising fat or lipid in adequate proportion

relative to the pharmaceutical / botanical agent, such that there is enough fat or lipid content in the confection to be effective alone to suppress the unpleasant flavor of the pharmaceutical or botanical agent, which is also the intent of the applicant.

(B) Claims 3 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuragi in view of Seang, further in view of either Raymont (AU 9671904 A) or Emanuel–King (US 5248503).

Katsuragi in view of Seang has been applied to claims 1, 2, 4-9, 28, 29, 31-36 and 55 above.

Katsuragi teaches Ginkgo biloba added to lozenges/troches, but is silent in teaching a hard candy with Echinacea as recited in claims 3 and 30. Raymont and Emanuel King have been relied on as evidence of the conventionality of adding Echinacea to lozenges/troches/ breath dots etc. Raymont teaches the combination of active ingredients has a significant synergistic effect such that the therapeutic effect is greater than a merely additive effect. In particular, Raymont teaches that Echinacea provides immune system benefits (Page 2, lines 7-12, Page 3, lines 10-31, Page 5, line 22). Therefore, to include Echinacea would have been an obvious matter of choice, depending on the desired benefit of the botanical (e.g. improving the immune system). One would have been substituting one conventional botanical for another for the same purpose: providing a medical benefit in a hard candy form. One would have been further motivated include Echinacea to the troches or candy with botanicals like Ginkgo, as taught by Katsuragi, to make a confection comprising the added benefit from the synergistic effect of Ginkgo and Echinacea.

Response to Arguments

Applicant's arguments submitted November 11, 2007 regarding the rejection have been fully considered but have not been found persuasive.

I Applicant's argument that in the instantly claimed invention the vegetable oils or saturated fats in the stated amounts in the confection "avoid the need to have any other masking agent" (Remarks, page 14, paragraph 2) is not convincing.

(i) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "avoid the need to have any other masking agent") is not recited in the rejected claims 1, 28 and 55. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(ii) The independent claims recite "one or more partially hydrogenated vegetable oils or saturated fats, said amount being effective alone to suppress said unpleasant mouth feel of said botanical." The term "alone" as recited in claims 1, 28 and 55 as recited is unclear (see 112 second rejection above). However, applicant's remarks on pages 15 and 16 state that "Katsuragi does not teach ...these ingredients as the sole taste masking agent" ,i.e., there is no other masking agent in the composition as taught.

Applicant's remarks making the lipid or fats as the only taste masking agent in the confection composition was not described in the specification as such. While it may be true that the one or more partially hydrogenated vegetable oils or saturated fats, said amount being effective to suppress said unpleasant mouth feel of a botanical, however, there is no evidence or support provided by the applicant that shows that the fats are able to suppress the unpleasant mouth feel *alone*, i.e., to the exclusion of all other components of the confection. Applicant's arguments on pages 14-16, regarding the ability of vegetable oils or saturated fats alone to suppress the unpleasant moth feel is not supported by the rejected claims which clearly recite presence of at least one sugar an one carbohydrate bulking agent in the composition. It is also noted that the claims 1, 28 and 55 recite "a candy composition.. comprising", i.e., composition may have other ingredients in it. Further applicant's disclosure includes the addition of flavorants

and acids to the confection (Specification page 7, lines 30-32 and Example 2, Page 10) . Thus the claims and specification discloses use of sugar, carbohydrate bulking agents, flavors and acids in the confection which would affect the mouth feel of the confection as recited. Therefore, at least for the reasons provided, applicant's claim that one or more partially hydrogenated vegetable oils or saturated fats are effective *alone* to suppress said unpleasant mouth feel of confection with botanical has not been considered persuasive. Also the recitation of "amount being effective alone to suppress said unpleasant mouth feel of said botanical" is unclear as discussed in the rejection under 35 U.S.C. 112 above.

Furthermore Katsuragi is being relied in an obviousness rejection and not in an anticipation rejection and Katsuragi in view of Seang teaches all the features of the independent claims 1, 28 and 55.

II Applicant's arguments regarding Katsuragi and Seang (Remarks, page 14-17) have been considered and are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(i) Regarding the argument that Katsuragi requires the ester of a glyceride to be present in the taste masking agent and not just the fats, applicant is referred to the fact that fats are triesters of glycerol and fatty acids. Thus by definition ester of glycerol with fatty acids is a fat. Applicant is further referred to the rejection of claims where Katsuragi teaches that the bitterness-relieving agent comprises an ester of a glyceride (mono/di-glyceride and triglycerides, i.e., fats and oils) where the preferred fatty acids (either saturated or unsaturated) range from 8-22 carbon atoms, including lauric acid, stearic acid, oleic acid, linoleic acid and linolenic acid (Page 3, lines 3-20). Katsuragi further teaches that ester of

Art Unit: 1794

glyceride is further dissolved in edible oils (hydrogenated, trans-esterified or regular), such as palm kernel oil, milk fat and cottonseed oil to name a few, before being added to food (Page 3, line 58 to Page 4, line 7) as instantly claimed. Thus Katsuragi teaches of a fat based bitterness relieving composition comprising of esterified fatty acids with glycerol, i.e., fats.

(ii) Regarding the references not teaching the "...these ingredients as the sole taste masking agent" or the fats in the specified amount being effective alone to suppress said unpleasant mouth feel of said botanical as recited in the independent claims and pages 15 and 16 of the remarks, applicant is referred to the office action above where the claimed matter has been addressed by Seang. Seang teaches of saturated or partially hydrogenated oils in the range recited by the applicant and shows that it is effective alone to suppress the bitter or unpleasant flavor, as discussed in the rejection above.

III In response to applicant's argument that "modifying Katsuragi by the teaching of Seang would still not arrive at the claimed invention" and "no teaching ...of eliminating Katsuragi's ester" (Remarks, Page 16), applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Further, regarding Katsuragi's ester (Remarks, page 16, applicant is referred to Response to argument II (i) where it is discussed in greater detail.

IV Regarding applicant's argument that "neither Raymont nor Emanuel-King teach fats as an unpleasant mouth feel suppressing agent", (remarks, page 17), applicant is reminded that in an obviousness rejection, one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since Katsuragi and Seang teach of the claimed invention other than the addition of Echinacea as the botanical with unpleasant flavor as claimed in claims 3 and 30, therefore, Raymont or Emanuel-King do not have to teach every limitation of the instantly claimed invention.

Thus applicant's arguments submitted November 11, 2007 regarding the rejections have been fully considered but have not been found persuasive and the rejections of claims 1-9, 28-36 and 55 are maintained for reasons of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1761

Jyoti Chawla
Examiner
Art Unit 1794